



Docket: 202462US-2

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

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Re: Group Art Unit: 2876  
Serial No.: 09/769,510  
Filed: JANUARY 26, 2001  
Applicant: TOMOHIRO NAKAJIMA, ET AL.  
For: OPTICAL SCAN MODULE, OPTICAL SCANNER,  
OPTICAL SCAN METHOD, IMAGE GENERATOR...

Attached hereto for filing are the following papers:

**RESPONSE TO AN ELECTION OF SPECIES REQUIREMENT**

Our check in the amount of \$ - 0 - is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate of this sheet is enclosed.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: :  
TOMOHIRO NAKAJIMA, ET AL : GROUP UNIT: 2876  
SERIAL NO: 09/769,510 :  
FILED: JANUARY 26, 2001 : EXAMINER: PAIK, S.  
FOR: OPTICAL SCAN MODULE, :  
OPTICAL SCANNER, OPTICAL :  
SCAN METHOD, IMAGE...

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*C. Stang*  
*11-26-02*

**RESPONSE TO AN ELECTION OF SPECIES REQUIREMENT**

ASSISTANT COMMISSIONER FOR PATENTS  
WASHINGTON, D.C. 20231

SIR:

In response to the communication dated October 21, 2002, and further in response to the Election of Species Requirement contained therein. Applicants herein provisionally elect the species listed as "Group I: Figures 1, 3, and 4, drawn to an optical scan module" in the Requirement and further list Claims 1-71 as readable thereon.

In addition, Applicants respectfully point out that the Election of Species Requirement is in error because it incorrectly states that the species of "Group II: Figures 2, 7 and 9" is "drawn to an image reader/generator system." To the contrary, the specification describes each of Figures 2, 7 and 9 as showing an "optical scan module," not an "image reader/generator system."

Moreover, Applicants respectfully point out that the Election of Species Requirement

See the specification at page 15, lines 12-14, where Fig. 1 is described as showing the optical

scan module 101 in "exploded state," while Fig. 2 is described as showing "a section of the optical scan module 101 in an assembled state."

Therefore, the listing of the asserted species of Groups I and II in the outstanding Election of Species Requirement is clearly erroneous. In this regard, note the following from MPEP §806.04(f):

Claims to be restricted to different species must be mutually exclusive. (Emphasis added.)

Not only is the outstanding Election of Species Requirement in error in listing Figures 1 and 2 as being drawn to separate species and asserting that Figures 2, 7, and 9 show "an image reader/generator system," instead of the optical scanner modules actually shown thereby, it further errs in failing to consider that the optical scanner modules are disclosed and claimed as being separate subcombinations (see Claims 1-71) and as being in combination with other elements to form the "image generator" of Claims 72-74 and "image reader" of Claims 75-77. In this regard, before the PTO can make a requirement to elect either the "optical scanner module" subcombination or the "image reader/generator" combination claims including the separately claimed optical scanning module subcombinations, it must, by directive of its own MPEP guidelines, establish distinctness under the appropriate one of MPEP sections 806.05(a)-806.05(i). See MPEP §806.04(b) requiring that distinctness must always be shown between inventions disclosed to be related, e.g., a combination-subcombination relationship, even if it is asserted that such inventions are also species.

Accordingly, it is respectfully urged that this Election of Species Requirement should be withdrawn because of the above-noted errors and that an Action on the merits as to all of Claims 1-77 should be forthcoming.

Respectfully submitted,

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